

REMARKS

Favorable reconsideration of this application, in light of the preceding amendments and following remarks, is respectfully requested.

Claims 1-25 are pending in this application, of which claims 1-14 and 24 are withdrawn as being directed to a non-elected invention. By this Amendment, claims 15-23 and 25 are amended. No new matter is added. Claims 1 and 15 are the independent claims.

Applicants note with appreciation the Examiner's acknowledgement that certified copies of all priority documents have been received by the U.S.P.T.O.

Applicants also appreciate the Examiner's indication that the Information Disclosure Statement filed on January 31, 2005, has been considered.

Applicants also respectfully note the present action indicates that the drawings have been accepted by the Examiner.

Objections to the Claims

Claim 15 is objected to because of a typographical error regarding the phrase "the layer or resilient." By this amendment, claim 15 has been amended to obviate the objection. Withdrawal of the objection is respectfully requested.

Claim Rejections - 35 U.S.C. § 102

I. Garcia

Claims 15-18 and 22-23 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,254,039 ("Garcia"). Applicants respectfully traverse this rejection for the reasons discussed below.

Applicants respectfully submit that the Garcia reference fails to disclose or suggest each and every element of claim 15, and therefore, an anticipatory rejection has not been established.¹

For example, claim 15, as amended, recites, *inter alia*:

air chambers are formed ***in*** the relatively hard substrate and/or the layer of resilient and/or damping material. (*emphasis added*)

Garcia, on the other hand, discloses a playable surface including a hard ground surface 14 ("a relatively hard substrate"), a layer of padding 12 (at least one layer arranged thereon of a resilient and/or damping material"), and a strip of artificial grass 22 ("a top layer") arranged in turn thereon. The air chambers ("inflatable dome-shaped ribs" 18) as disclosed by Garcia are not formed ***in*** either the relatively hard substrate 14 or the layer of resilient and/or damping material 12, but rather in a separate layer – defined by the dome-shaped ribs 18 and the filler material 20 – arranged between the resilient and/or damping layer 12 and the top layer 22.

In addition, since Garcia is silent about the nature of the filler material 20, it is submitted that the combination of the dome-shaped ribs 18 and the filler material 20 cannot in itself be considered to constitute a layer of resilient and/or damping material as taught by claim 15. Moreover, since Garcia seems to require the dome-shaped ribs 18 to be *inflated* in order to form air chambers, it is even questionable if the structure disclosed by Garcia includes air chambers in the normally installed state of the playable surface.

Therefore, contrary to the Examiner's contention, the Garcia reference does not disclose or suggest each and every element of claim 15. Since the Garcia reference

¹ A claim is anticipated only if each and every element as forth in the claim is found, either expressly or inherently described, in a single prior art reference. See MPEP § 2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

fails to disclose each and every element of claim 15, it cannot provide a basis for a rejection under 35 U.S.C. § 102(b) and, thus, is allowable. Claims 16-18 and 22-23 depend from amended claim 15 and, therefore, allowable for the similar reasons discussed above with respect to claim 15.

For at least these reasons, the Examiner is respectfully requested to reconsider and withdraw the § 102(b) rejection of claims 15-18 and 22-23.

II. Magnusson

Claims 15 and 20 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,460,867 ("Magnusson"). Applicants respectfully traverse this rejection for the reasons discussed below.

As similarly discussed above, Applicants respectfully submit that the Magnusson reference also fails to disclose, or even suggest, *inter alia*, "air chambers are formed in the relatively hard substrate and/or the layer of resilient and/or damping material," (*emphasis added*), as recited in amended claim 15.

Instead, Magnusson discloses a playable surface having a support surface 13 of sand or gravel ("a relatively hard substrate"), a rubber matting 11 ("at least one layer arranged thereon of a resilient and /or damping material"), and an artificial grass surface 10 ("a top layer") arranged in turn thereon. Magnusson further discloses air chambers are formed between a separation layer 12 made from a rigid plastic sheeting, which is laid on top of the relatively hard substrate 13, and the lower surface - provided with hollows - of the resilient and/or damping layer 11. However, it is submitted that there are no air chambers in either the substrate 13 or the layer 11. Moreover, the resilient and/or damping layer 11 is not arranged on the substrate 13, but rather on the separation layer 12.

Nonetheless, even if the hollows in the rubber matting 11 were to be considered to form air chambers in this layer, the air chambers would not be air chambers “formed during or after arranging of the layer.” Instead, the layer 11 would then have to be considered to have been manufactured from a specially preprocessed material, which is mentioned as a drawback of the prior art when compared to the claimed invention, *see, e.g., page 2, lines 23-28 of the originally filed disclosure.*

Accordingly, Applicants respectfully submit that Magnusson fails to disclose or suggest “air chambers are formed in the relatively hard substrate and/or the layer of resilient and/or damping material during or after arranging of the substrate or layer respectively,” as recited in amended claim 15.

Therefore, contrary to the Examiner’s contention, the Magnusson reference does not disclose or suggest each and every element of claim 15. Since the Magnusson reference fails to disclose each and every element of claim 15, it cannot provide a basis for a rejection under 35 U.S.C. § 102(b) and, thus, is allowable. Claim 20 depends from amended claim 15 and, therefore, allowable for the similar reasons discussed above with respect to claim 15.

For at least these reasons, the Examiner is respectfully requested to reconsider and withdraw the § 102(b) rejection of claims 15 and 20.

Claim Rejections - 35 U.S.C. § 103

Claim 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Garcia in view of Official Notice. Applicants respectfully traverse this rejection for the reasons discussed below.

Claim 19 is believed to be allowable for at least the reasons set forth above regarding claim 15. Since claim 19 is patentable at least by virtue of its dependency

on claim 15, Applicants respectfully request that the rejection of claim 19 under 35 U.S.C. § 103(a) be withdrawn.

Claim 21 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Garcia in view of U.S. Patent No. 4,007,307 ("Friedrich"). Applicants respectfully traverse this rejection for the reasons discussed below.

Claim 21 is believed to be allowable for at least the reasons set forth above regarding claim 15. The Friedrich reference fails to provide the teachings noted above as missing from the Garcia reference. Since claim 21 is patentable at least by virtue of its dependency on claim 15, Applicants respectfully request that the rejection of claim 21 under 35 U.S.C. § 103(a) be withdrawn.

Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Magnusson in view of Friedrich. Applicants respectfully traverse this rejection for the reasons discussed below.

Claim 25 is believed to be allowable for at least the reasons set forth above regarding claim 15. The Friedrich reference fails to provide the teachings noted above as missing from the Magnusson reference. Since claim 25 is patentable at least by virtue of its dependency on claim 15, Applicants respectfully request that the rejection of claim 25 under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

In view of the above remarks and amendments, Applicants respectfully submit that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. Further, the above remarks demonstrate the failings of the outstanding rejections, and are sufficient to overcome the rejections. However, these remarks are not intended to, nor need they, comprehensively address each and every

reason for the patentability of the claimed subject matter over the applied prior art. Accordingly, Applicants do not contend that the claims are patentable solely on the basis of the particular claim elements discussed above.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant hereby petitions for a three (3) month extension of time for filing a reply to the outstanding Office Action and submit the required \$555 extension fee herewith.


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned, at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKY, & PIERCE, P.L.C.

By


Donald J. Daley, Reg. No. 34,313

P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

DJD/DJC:clc